

REMARKS

The amendment does not involve new matter. Claim 26 have been amended to make explicit that the coating is formed by a panning procedure, as disclosed on pages 11-13 of the application.

Claims 6, 11, 24-27, 30 and 31 were rejected in the outstanding Office Action under 35 U.S.C. §103(a) as unpatentable over U. S. Patent No. 5,480,668 (Nofre '668) in view of U.S. Patent No. 4,997,659 (Yatka). This rejection is respectfully traversed. Claims 6, 24-25 and 30 require using a N-substituted derivative of aspartame as part of a rolling compound on a chewing gum product. Claims 11, 26-27 and 31 require using an N-substituted derivative of aspartame as part of a coating formed by panning a chewing gum pellet . While Nofre '668 discloses the N-substituted derivatives of aspartame used in the present invention, Nofre makes no suggestion for using the disclosed sweeteners in a rolling compound for chewing gum or in a panned chewing gum coating.

Yatka, on the other hand, discloses different ways of using a completely different sweetener, alitame, in chewing gum. While Yatka discloses using alitame as a part of a rolling compound and in a pellet coating, there is no suggestion in Yatka to use other sweeteners in this fashion. There is no reason from the references themselves to combine the references and treat N-substituted derivatives of aspartame the way alitame was treated. This rejection is thus based on hindsight.

Just because one high-potency sweetener was used in a particular fashion in producing chewing gum does not mean that it would have been obvious to use other high-potency sweeteners in the same fashion. Moreover, alitame was suggested for use in these ways in Yatka because of a desire to delay its release or separate it from other ingredients which may cause the alitame to degrade. The need for delayed release or prevention of degradation has not been shown in the prior art as being applicable to N-substituted derivatives of aspartame. Rather, Nofre '668 shows the stability of the N-substituted derivatives of aspartame disclosed therein when used in chewing gum (see Col. 3, lines 51-60); and there is no suggestion that the materials release too quickly from chewing gum.

The Office Action concedes that Nofre '668 does not express a need for delayed release of aspartame derivative or prevention of degradation, but then goes on to make the statement, "the need to prevent degradation also exists." There is no support for this statement. Nor is there any prior art that teaches this that Applicants' attorney is aware of. Rather, it is Applicants that suggest, in the present application, the need for modifying the N-substituted derivative of aspartame to increase its stability. Since the prior art does not teach this need, but in fact teaches that N-substituted derivatives of aspartame are stable in chewing gum formulations (Nofre '668 col. 3, lines 51-60), there is no motivation from the prior art to make the invention as claimed.

The Office Action notes that Nofre '668 teaches to mix an N-substituted derivative of aspartame with alitame and then add that mixture into chewing gum. The Office Action then goes on to argue that it would have been obvious to use this mixture in place of the pure alitame in the way that Yotka teaches to use the alitame by itself. This argument is also based on hindsight. The most that a person of ordinary skill in the art would learn from Nofre '668 is to add the mixture to edible products, not even chewing gum specifically. Again, there is no teaching in Nofre '668 to use the mixture in other ways, or to use it in place of alitame in all other ways that alitame is used. Nor is there anything in Yotka that teaches to use combinations of sweeteners in place of alitame. There is nothing in Yotka that would suggest treating a combination of alitame and an N-substituted derivative of aspartame the same way that alitame was used, and nothing in Nofre '668 that would suggest looking at Yotka for ideas about how to include mixtures of alitame and an N-substituted derivative of aspartame in chewing gum products. While Yotka teaches to use alitame in a chewing gum coating or in a rolling compound, it does not suggest that any other high-potency sweetener should be mixed with the alitame and used in the same way. The simple fact of the matter is that the combination suggested by the Office Action in making the rejection would not have been made without hindsight of the present invention.

The Office Action includes the statement that , "Since Nofre et al ('668) uses alitame and an aspartame derivative together in chewing gum and since Yotka et al suggests applying alitame as part of a rolling compound or coating it thus becomes

obvious to apply to chewing gum any sweetener mixture, which includes alitame in the manner, disclosed by Yotka et al. There would be no reason to separate the alitame from the aspartame derivative in Nofre et al ('668) and apply them separately by two different techniques, viz. coat with alitame and mix with aspartame derivative." This statement presumes that there has been a showing of motivation to use the combined sweeteners in Nofre '668 in the manner taught by Yotka to use pure alitame. The statement "it thus becomes obvious" is unsupported, and contradictory to the requirements for finding unpatentability under 35 U.S.C. §103(a).

In order for a *prima facie* case of obviousness to be established, the teachings from the prior art itself must suggest the claimed subject matter to one of ordinary skill in the art. The mere fact that the prior art could be modified as proposed in the Office Action is not sufficient to establish a *prima facie* case of obviousness. The Office Action must explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the modification. See *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The Office Action gives no explanation of any motivation to treat a mixture disclosed in one reference in the same way a pure material is treated in another reference, and logic actually compels the opposite conclusion. A combination of sweeteners might very well behave differently than a pure sweetener would. Therefore one would not presume that combinations of materials can be used in the same fashion that pure materials can be used. Without a suggestion in Yotka or Nofre '668 to use the combination of sweeteners in Nofre '668 in the manner the pure alitame sweetener is used in Yotka, there is no *prima facie* case of obviousness. While there may be no reason to separate the alitame from the aspartame derivative in Nofre '668, there is also no reason to use the mixture as a rolling compound or in a panned coating.

Claims 6, 11, 24-27, 30 and 31 were rejected in the outstanding Office Action under 35 U.S.C. §103(a) as unpatentable over U. S. Patent No. 5,510,508 (referred to on the face of the patent as Claude et al., but referred to in the Office Action as Nofre et al. 5,510,508, and referred to herein as Nofre '508) or Nofre '668 in view of U.S. Patent No. 4,374,858 (Glass). This rejection is respectfully traversed. Nofre '508 discloses methods of preparing a particular N-substituted derivative of aspartame, but the same

material is disclosed in Nofre '668. Nofre '508 also suggests that the compound can be used in chewing gum, but so does Nofre '668. There is no suggestion in Nofre '508 of using the particular N-substituted derivative of aspartame in a rolling compound or panned coating on a chewing gum pellet. Thus Nofre '508 is considered to be cumulative to Nofre '668.

Glass discloses an aspartame sweetened chewing gum, including the use of aspartame in a rolling compound. Col. 4, lines 16-38 outline a test that was conducted to show that aspartame used in this fashion was more stable than aspartame mixed into a chewing gum composition. However, there is no suggestion of using other high-intensity sweeteners in the same fashion, and no suggestion of using N-substituted derivatives of aspartame.

Just as with the rejection based on Nofre '668 in view of Yotka, there is no explanation in the Office Action of any motivation for combining the references. There is no suggestion in Nofre '668, Nofre '508 or Glass of using a sweetener used in the way disclosed in one reference the way that sweeteners used in another reference are used. It is only by hindsight of the present invention that one would consider combining these references. Further, since Nofre '668 teaches that N-substituted derivatives of aspartame are stable in chewing gum compared to aspartame, there would be no reason from Nofre '668 to use N-substituted derivatives in a manner that aspartame was used in Glass to increase its stability. Thus, claims 24 and 26, and the claims dependent thereon, are patentable over the cited references.

Claim 26 and the claims dependent thereon are further patentable over Nofre '668, Nofre '508 and Glass. None of these references disclose the use of any high-intensity sweetener in a panned coating on a chewing gum pellet.

Since each of the reasons for the rejections have been overcome, it is believed that the case is in condition for allowance. An early notice of allowance is therefore respectfully requested.

Respectfully submitted,

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